

### **Remarks**

In view of the above amendments and the following remarks, reconsideration of the rejections and further examination are requested.

Claim 1, 2, 8-22, 24 and 31 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Heim (US 2005/0151368) in view of Mayer (US 6,565,770).

Claim 1 has been amended so as to further distinguish the present invention, as recited therein, from the references relied upon in the rejection. Support for the amendments can be found in the original specification at least at Figures 1-6.

The rejection is submitted to be inapplicable to the amended claims for the following reasons.

Claim 1 is patentable over the combination of Heim and Mayer, since claim 1 recites a forgery-proof security element including, in part:

a first layer formed of metal clusters located on a first side of a polymeric spacer layer and a second layer formed of metal clusters located on a second side of the polymeric spacer layer, the second side being opposite to the first side,

wherein the metal clusters of the first layer are spaced apart from each other such that adjacent metal clusters are not in contact, and

wherein the metal clusters of the second layer are spaced apart from each other such that adjacent metal clusters are not in contact.

The combination of Heim and Mayer fails to disclose or suggest the first and second layers formed of metal clusters as recited in claim 1.

Heim discloses a security element 2 having a layered structure including a transparent substrate S, an absorber layer A2, a dielectric layer D and an absorber layer A1. The absorber layers A1, A2 can be formed by physical vapor deposition (PVD) or chemical vapor deposition (CVD). (See paragraphs [0017], [0021], [0057], [0058] and [0063] and Figure 5).

In the rejection, the absorber layers A1, A2 are relied upon as corresponding to the claimed first and second layers. However, the claimed first and second layers A1, A2 are specifically recited as being formed of metal clusters that are spaced apart from each other such that adjacent metal clusters are not in contact. On the other hand, the absorber layers A1, A2 are not formed of metal clusters that are spaced apart from each other such that adjacent metal

clusters are not in contact, but are continuous layers. This is clearly illustrated in Figure 5 of Heim. Therefore, Heim does not disclose or suggest the claimed first and second layers formed of metal clusters as recited in claim 1.

Regarding Mayer, it is relied upon in the rejection as disclosing dielectric layers 54a, 54b formed of a polymer. Mayer also discloses absorber layers 56a, 56b formed on the dielectric layers 54a, 54b. The absorber layers 56a, 56b can be formed by vapor deposition or sputtering. (See column 8, lines 29-44; column 14, lines 27-47; column 16, lines 27-44; and Figure 2).

While Mayer also discloses the absorber layers 56a, 56b formed by vapor deposition (or sputtering), it is clear that, like Heim, Mayer fails to disclose or suggest that the absorber layers 56a, 56b are formed of metal clusters that are spaced apart from each other such that adjacent metal clusters are not in contact. Instead, Figure 2 of Mayer clearly illustrates that the absorber layers 56a, 56b are formed as a continuous sheet and not a series of metal clusters that are spaced apart from each other such that they are not in contact. Therefore, Mayer fails to address this deficiency of Heim. As a result, claim 1 is patentable over the combination of Heim and Mayer.

Claim 7 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Heim in view of Mayer and further in view of Chen (US 4,792,667).

Regarding this rejection, Chen fails to address the deficiencies noted above with regard to the combination of Heim and Mayer. Therefore, claim 7 is patentable over the combination of Heim, Mayer and Chen based at least on its dependency from claim 1.

Claims 23 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Heim in view of Mayer and further in view of Adamczyk (US 2004/0050269).

Regarding this rejection, Adamczyk fails to address the deficiencies noted above with regard to the combination of Heim and Mayer. Therefore, claims 23 and 25 are patentable over the combination of Heim, Mayer and Adamczyk based at least on their dependency from claim 1.

Regarding withdrawn claims 3-6, 26-30 and 32-35, it is submitted that these claims should be given due consideration based on their dependency from allowable claim 1.

Because of the above-mentioned distinctions, it is believed clear that claims 1-35 are allowable over the references relied upon in the rejections. Furthermore, it is submitted that the distinctions are such that a person having ordinary skill in the art at the time of invention would

not have been motivated to make any combination of the references of record in such a manner as to result in, or otherwise render obvious, the present invention as recited in claims 1-35. Therefore, it is submitted that claims 1-35 are clearly allowable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that there are issues remaining which must be resolved before allowance of the application.

Respectfully submitted,

Martin BERGSMANN et al.

/David M. Ovedovitz/

By 2010.10.28 12:02:10 -04'00'

David M. Ovedovitz  
Registration No. 45,336  
Attorney for Applicants

DMO/jmj  
Washington, D.C. 20005-1503  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
October 28, 2010